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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,057	08/01/2001	Valteri Niemi	324-010477-US (PAR)	4430
2512	7590	10/12/2005	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			DAVIS, ZACHARY A	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,057

Applicant(s)

NIEMI ET AL.

Examiner

Zachary A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. An amendment was received on 05 August 2005. Claims 1, 3, 5, 7-9, 11-13, 15, 17, 19, 21, 23-25, 27-29, 31, 33, 35, 37, 39-41, 43-45, and 47 have been amended. No claims have been added or canceled. Claims 1-48 are currently pending in the present application.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The certified copy of the Finnish priority document was received on even date with the filing of the application; however, a translation of the priority document has not been received. It is noted that a translation is not required to perfect the claim for priority.

Information Disclosure Statement

3. The information disclosure statement filed 17 January 2002 was placed in the application file, but the information referred to therein has not been considered, because it fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in the English language, as set forth in the previous Office action. Although Applicant's remarks (page 20 of the

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present response) state that a new IDS was filed including English translations of the references cited in the above IDS, no such documents have been received. Therefore, the information has not yet been considered.

Oath/Declaration

4. Acknowledgement is made of receipt of a substitute declaration, which acknowledges the filing of the Finnish application relied upon for foreign priority.

Response to Arguments

5. Applicant's arguments filed 05 August 2005 have been fully considered but they are not persuasive.

Claims 1-48 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-48 were further rejected under 35 U.S.C. 102(e) as being anticipated by Fauconnier et al, US Patent 6768903.

6. In reference to the rejection under 35 U.S.C. 112, second paragraph, specifically regarding the use of the terms "GPRS/EDGE" and "universal mobile telecommunications system" (UMTS), Applicant argues that the use of these terms does not render the claims indefinite. The Examiner respectfully disagrees. Applicant agrees with the Examiner's characterization of "GPRS/EDGE" and "UMTS" as protocols under constant development, subject to evolving standards and going through several version

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revisions. The Examiner notes that Applicant makes specific reference to particular versions of specifications that are part of the UMTS specification in the specification of the present application (at paragraph 0013). Applicant further argues that one skilled in the art would readily know the meaning of the terms "GPRS/EDGE" and "UMTS" at any point in time regardless of evolving standards or revisions (page 21 of the present response); the Examiner notes that, while that may be the case, the terms at issue could also evolve to describe systems entirely unforeseen and not encompassed by the definitions as presently understood. The Examiner notes that the state of the art is unpredictable, and that Applicant is not entitled to claim a future version of an existing protocol without disclosure of the specifics thereof. It is recommended that Applicant amend the claims either to refer to a specific version of the protocol specifications, or to remove all references to the terms "GPRS/EDGE" and "UMTS" and replace them with a suitable generic description of the required systems.

7. In reference to the rejection under 35 U.S.C. 102(e), Applicant argues that the Fauconnier patent does not anticipate the claimed invention because the filing date of Fauconnier is after the priority date of the present application. An English translation of a non-English language foreign application in accordance with 37 CFR 1.55 is required to overcome the date of a reference relied upon in a rejection. Although Applicant's remarks (page 22 of the present response) state that an English translation of the Finnish priority document and a statement of accuracy was filed concurrently with the present response, no such documents have been received. Therefore, the rejection under 35 U.S.C. 102(e) has not been overcome.

8. Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 17, and 33 contain the limitations “GPRS/EDGE” and “universal mobile telecommunications system” (or UMTS), naming protocols in general. Where a protocol name is used in a claim as a limitation to identify a particular product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph, similar to the use of a trademark or trade name in a claim (See MPEP § 2173.05(u)). The claim scope is uncertain because the protocols are subject to evolving standards and go through several version revisions, and therefore the protocol names cannot be used to properly identify the specific methods, standards, or products that are associated with the protocol names.

Further in reference to Claim 13, the claim recites the limitation “the value of the number formed by most significant bits”. This is generally unclear, as there is no basis

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for comparison established regarding how many bits are considered "most significant".

This renders the claim indefinite.

Claims not specifically referred to above are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Fauconnier et al, US Patent 6768903.

In reference to Claim 1, Fauconnier discloses a method for transmitting data between a GPRS/EDGE network and a user mobile equipment, that includes encrypting data to be transmitted, transmitting the encrypted data, and deciphering the transmitted data (see column 3, line 63-column 4, line 2), and in which the encryption algorithm of a UMTS network is used with parameters adapted to parameters of the GPRS/EDGE network (see column 4, lines 61-67, where it is possible to use the same ciphering procedures in a UTRAN and a GERAN).

In reference to Claim 2, Fauconnier further discloses that a format of the parameters includes a number and length of each parameter (column 4, lines 5-16).

In reference to Claim 3, Fauconnier further discloses that the implementation of the encryption algorithm is the same in both the GPRS/EDGE network and the UMTS network (column 4, lines 61-67).

In reference to Claims 4 and 5, Fauconnier further discloses a counter parameter (column 4, lines 8-9; and, for example, column 10, lines 23-35, noting the ciphering sequence number CSN).

In reference to Claims 7, 8, 11, and 12, Fauconnier further discloses that the encryption algorithm can be executed in either the MAC layer or the RLC layer (column 5, lines 37-41), and that the counter parameter includes a frame number (column 5, lines 49-54).

In reference to Claims 9, 10, 13, and 14, Fauconnier further discloses that the most significant bits of a previously used frame number are stored and incremented before a new connection is made (column 10, lines 8-14 and 52-60).

In reference to Claim 6, Fauconnier further discloses the use of a bearer parameter (column 4, lines 10-11; column 9, lines 19-22).

In reference to Claims 15 and 16, Fauconnier further discloses that when a handover is made between networks, the most significant bits of a previously used frame number are stored and used in both networks, after having been incremented (column 10, lines 8-14 and 52-60).

Claims 17-32 are directed to an apparatus, specifically user equipment, that corresponds substantially to the method of Claims 1-16, and are rejected by a similar rationale.

Claims 33-48 are directed to an apparatus, specifically a radio access network, that corresponds substantially to the method of Claims 1-16, and are rejected by a similar rationale.

13. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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